

REMARKS

Claims 1-6 and 15-22 are pending as previously withdrawn claims 7-10 are herein cancelled. In the Office Action mailed May 7, 2010, the Examiner reiterated the rejection of claims 20-22 under 35 U.S.C. §112, second paragraph as being indefinite. With respect to the prior art, the Examiner further maintained the rejection of claims 1-6 and claims 15-22 under 35 U.S.C. §102(b) as being anticipated by WO 00/61344 (which corresponds to U.S. Patent 6,808,384 to Jordan et al.). A telephone conference with the Examiner was held on May 13, 2010 with the undersigned and Attorney Kirk Deheck (55,782) discussing the outstanding rejections of the pending claims. Applicant appreciates the Examiner's time and efforts in discussing the matter. Applicant has amended the claims as suggested by the Examiner during the telephone conference and believes the claims as presented herein are in compliance with 35 U.S.C. §112, second paragraph and are patentably distinct over the art of record.

§112, Second Paragraph Rejection

With respect to the §112, second paragraph rejections, the Examiner discussed possible confusion with respect to the recitation of the "operating state change means for" recited in claim 20 and the recitation in claim 21 that "the operating state change means further comprises automatic operation switch means for switching the operating state change device off and on." As discussed during the telephone conference mentioned above, the "operating state change means for" is disclosed in the application as an automatic operation switch means 9 and the equivalents thereof. Applicant has amended claim 21 as suggested by the Examiner to resolve the §112, second paragraph rejection. As explained further below, Applicant believes claim 20 clearly and concisely defines the present invention and claims 21 and 22 further define the subject matter of claim 20. As amended, Applicant believes claims 20-22 satisfy the requirements of 35 U.S.C. §112, second paragraph.

The use of "means for" language is expressly authorized under 35 U.S.C. §112, paragraph six, and, as explained in MPEP §2181, entitles the scope of such a limitation to include both the disclosed structure and equivalents thereof. Accordingly, the scope of claim 20 includes the limitation of operating state change means for and the equivalents thereof. Claim 21

further limits the subject matter of claim 20, by the doctrine of claim differentiation, to further define that the operating state change means is an automatic operation switch thereby excluding the equivalents encompassed by claim 20. Although the Examiner expressed some concern regarding claim 22, Applicant believes claim 22 also further defines the operating state change means of claim 20 in a manner consistent with the requirements of 35 U.S.C. §112, second paragraph. Applicant believes that claims 20-22 as presented herein satisfy the requirements of 35 U.S.C. §112, second paragraph. Accordingly, Applicant requests that the §112, second paragraph rejections be withdrawn.

Prior Art Rejections

With respect to the prior art, the Examiner rejected claims 1-6 and 15-22 under 35 U.S.C. §102(b) as being anticipated by Jordan et al. As discussed during the telephone conference mentioned above, Jordan et al. discloses a vibration device that operates in two different steady conditions that are differentiated by clockwise and counterclockwise rotation of the exciter. Applicant does not necessary disagree that Jordan et al. discloses an on/off switch and a switch associated with designating the direction of rotation of the exciter. However, as evidenced by the §132 Declaration entered on May 3, 2010, Jordan et al. does not disclose or remotely suggest the automatic reversing of the direction rotation of the exciter as is called for in the pending claims.

Claim 1 has also been amended as suggested by the Examiner during the telephone conference to explicitly recite that the internal vibrator device includes an operating state change device. The operating state change device is further defined as allowing the operation of the internal vibrator device to be reversed automatically at periodic time intervals. Claim 17, as previously presented, calls for, in part, an operating state change device that is connected to the electric motor and that automatically reverses the direction of the electric motor at periodic time intervals. Likewise, claim 20, as previously presented, also calls for, in part, an operating state change means for automatically reversing the direction of the electric motor at periodic time intervals to operate the internal vibrator device. As discussed during the telephone conference, Jordan et al. does not disclose or remotely suggest any structure that provides automatically

reversing the direction of operation of the exciter as is called for in the pending claims. Furthermore, as evidenced by the §132 declaration, those skilled in the art would not be motivated to alter the assembly of the Jordan et al. to automatically reverse the operating direction of the exciter as doing so would undesirably yield uncertain compaction of fluid concrete.

As amended, claims 1, 17, and 20 each call for an operating state change device or means. Claims 1, 17, and 20 each further define the function of the operating state change device or means as automatically reversing the direction of operation of the exciter. In rejecting the claims, the Examiner asserts that “As the operating state change device is not one of the required elements of the claim, but instead is something with which the claims device can be used during intended operation, reference not disclosed such a device can still anticipate the claim.” As discussed above, each of claims 1, 17, and 20 expressly calls for an operating state change device or means. Further, claims 1, 17, and 20, each further define the function of the operating state device or means by the function of automatically reversing operation of the exciter.

MPEP §2173.05(g) expressly authorizes an applicant to define something by what it does rather than what it is. MPEP §2173.05(g) further requires that “A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used.” In addition, a prior art reference cannot be used to support a rejection based on anticipation where, as here, the cited reference is *incapable* of performing the claimed function. MPEP §2112 and *In re Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432. The previously-submitted §132 Declaration conclusively established that *no structure* of Jordan et al. is capable of automatic reversing the direction of operation of the exciter as is expressly called for in the pending claims. See Paragraphs 6-9 and especially paragraphs 7 and 8 of the Declaration. Accordingly, Applicant supports the claims 1, 17, and 20, and the claims that depend therefrom, are patentably distinct thereover.

It is believed that each of the Examiner's rejections has been addressed and overcome, and allowance of each of pending claims 1-6 and 15-22 is respectfully requested. Although no fees are believed due with this submission, the Director is authorized to charge any fees which may be considered due, or credit any overpayment, with this or any future communication, to Deposit Account No. 50-1170. Applicant appreciates the Examiner's time and consideration in discussing this matter during the telephone conference on May 13, 2010. Applicant further invites the Examiner to contact the undersigned should any matters remain which would hinder or otherwise delay passage of this matter to issuance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Timothy E. Newholm', with a long horizontal stroke extending to the right.

Timothy E. Newholm
Registration No. 34,400

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Customer Account No.: 23598
BOYLE FREDRICKSON, S.C.
840 North Plankinton Avenue
Milwaukee, WI 53203
Telephone: (414) 225-9755
Facsimile: (414) 225-9753
E-mail: *docketing@boylefred.com*